Supreme Court, U.S.
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No. 06-

IN THE

Supreme Court of the United States

RICHARD W. BERGER and BRANT W. BERGER,

Petitioners,

v.

ROSSIGNOL SKI COMPANY, INCORPORATED,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Does the application of local patent rules of the Northern District of California, which create a requirement to fix plaintiff's position by disclosure of infringement contentions early in a patent infringement case, unfairly and unlawfully deprive modest means inventors of a fair trial on claims of infringement of their lawful patent?

PARTIES TO THE PROCEEDING

Richard W. Berger and Brant W. Berger, father and son, are the inventors of the Berger 360 binding, patent number 5,913,530, and are the plaintiffs, and petitioners herein. Rossignol Ski Company, Incorporated, the respondent was the American subsidiary of Rossignol, S.A., the French snow sports company, and is now the subsidiary of Quicksilver, Inc., an American Company.

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OPINIONS BELOW

The decision of the United States Court of Appeals for the Federal Circuit was entered January 12, 2007, affirming the District Court's decision without opinion per FRAP 36 (App. A). The Decision of the Northern District of California, the Honorable Charles R. Breyer, was entered April 25, 2006, and Judge Breyer denied plaintiffs Rule 60(b) motion by order on July 17, 2006 (App. C and B respectively). The trial court had subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a).

JURISDICTION

This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

RULES INVOLVED

Patent Local Rules 3-1, 3-6, 3-7, of the United States District Court for the Northern District of California. Federal Rules of Civil Procedure 8, 15, and 83. The relevant portions of which are reproduced in Appendix D.

STATEMENT OF THE CASE

Petitioners request review of the affirmance by the United States Court of Appeals for the Federal Circuit of the judgment of the United States District Court for the Northern District of California, which denied Petitioners' patent infringement suit against Respondent, due to the mistake of counsel in drafting an erroneous "infringement contention" required by local rule, irrespective of the fact that no measurable prejudice to correct the mistake would have been

caused to Respondent and that correction of the mistake would have allowed plaintiff to pursue a meritorious case.

> . . . unlike the liberal policy of amending pleadings, the philosophy behind amending claims charts is decidedly conservative, and designed to prevent the "shifting sands" approach to claims construction.[*LG Electronics Inc. v. Q-LITY Computer Inc., et al.* (2002) 211 F.R.D 360, 367;

This is a reasoning and practice being adopted in other districts [*Massachusetts Institute of Technology v. Abacus Software* (2004) U.S. District Court Lexis 30045].

The Federal Circuit Court of Appeal, responsible for patent appeals, has upheld the conservative application of rules regarding infringement contentions in, *O2 Micro International Limited v. Monolithic Power Systems, Inc.*, (2006 Fed. Cir.) 467 F.3d 1355.

Therein the Court stated,

> . . . having concluded that the district court could properly conclude that O2 Micro [plaintiff] did not act diligently in moving to amend its infringement contentions, **we see no need to consider the question of prejudice to MPS [defendant].** (*Ibid*, pg.1368)(emphasis added)

The conservative application of the Northern District local rules regarding infringement contentions as applied by the District Court and the Federal Circuit Court of Appeal violates FRCP 83(a)(1) because it is inconsistent with the letter and spirit of the FRCP as found in Rules 8, 15(b), and Rule 83(a)(2).

> a local rule imposing a requirement of form shall not be enforced in a manner that causes a party to lose rights because of a non-willful failure to comply with the requirement.[Rule 83(a)(2)]

Local rules such as the Local Patent Rules of the Northern District of California, must be consistent with the Acts of Congress and must be consistent with the spirit and letter of statutes and the Constitution [*Weibrecht v. Southern Ill. Transfer, Inc.* (7th Cir. 2001) 241 F.3d 875, 879].

Petitioners were deprived of a meritorious patent infringement suit due to the improper and unfair application of local rules in violation of the Federal Rules of Civil Procedure. This extreme case of forfeiture graphically illustrates a greater policy being adopted nationwide regarding patent infringement claims, that severely prejudices the rights of individual inventors and entrepreneurs of modest means in the enforcement of their rightful patent law protection.

REASONS FOR GRANTING THE PETITION

Northern District of California Local Patent Rule 3-6 requires disclosure of preliminary infringement contentions which become final upon such initial disclosure except in limited circumstances. The District Court and the Federal Circuit Court of Appeal both apply the Northern District's local rules conservatively.

> . . . unlike the liberal policy for amending pleadings, the philosophy behind amending claim charts is decidedly conservative and designed to prevent the "shifting sands" approach to claim construction. *[LG Electronics Inc. v. Q-Lity Computer Inc., et, al.* (2002) 211 F.R.D 360, 367]

In reviewing motions for leave to amend infringement contentions, the Federal Circuit has determined that the District Court shall consider only the diligence, or lack thereof, of the moving party without regard to considerations of prejudice to responding party [*O2 Micro International Limited v. Monolithic Power Systems, Inc.*, (2006 Fed. Cir.) 467 F.3d 1355, 1368].

Preliminary infringement contentions are a vehicle to assist the Court in identifying which claims in the patent apply to the accused infringing device.

> Characteristically, patent lawsuits charge what is known as infringement, . . . and rest on the allegations that the defendant 'without authority made, used or sold the patented invention . . .' Victory in an infringement suit requires a finding that the patent claim 'covers the alleged infringer's

> product . . .' [*Markman v. Westview Instruments, Inc.* (1996) 517 U.S. 370, 374; 116 S. Ct. 1384; 134 L. Ed. 2d 577, quoting, 35 U.S.C. § 271 (a)]

Patent claims define the scope of the patent grant [*Markman v. Westview Instruments, Inc.*(*Ibid.* at 517 U.S. 373); 35 U.S.C. § 112]. Each claim in a patent document is numbered. Infringement contentions are typically expressed in a chart identifying the plaintiff's application of patent claims by number to a device accused of infringement, the components of which are also identified by number. As such, the infringement contentions reflect the allegations of plaintiff, not facts. The allegation is understood by simply looking at the relationship of the identified claim number to the identified component number of the accused device. In the typical patent case, as this one, multiple claim numbers are contained in a chart corresponding to multiple component numbers. Placing a component number in the wrong box has a material effect on the allegations of plaintiff. This is what happened in this case, one of the component numbers was mistakenly placed in the wrong box by counsel.

The determination of infringement is a two step analysis.

> First, the claims must be correctly construed to determine the scope of claims. Second, the claims must be compared to the accused devise. [*Kahn v. General Motors Corp.* (1998 Fed. Cir. 135) Fed. 3rd 1472, 1476 citing, *Markman v. Westview Instruments Inc.*, (Fed. Cir. 1995) 52 Fed. 3rd 967, 976].

Claim construction is exclusively the province of the courts and is a question of law [*see Markman v. Westview Instruments, Inc.* (*Supra* at 517 U.S. 372]. Comparison

of the claims to an accused devise involves factual determinations usually reserved to a jury. The notice pleading of a plaintiff identifies the patent, which would include the claims to be applied. Identifying a specific accused device typically occurs by Rule 26 disclosures. The obligation of the Court is to compare the claims of the patent to the accused device. The "infringement contentions" is a map created by plaintiff to assist the Court in identifying how the specific claims apply to the accused device. They are not, however, a lawful replacement of the pleading of plaintiff, nor are they facts. They are merely refined contentions set forth in a form for the aid of the Court and the parties. Infringement contentions arise from "a local rule imposing a requirement of form .. ." [FRCP 83(a)(2)]. As peculiarly illustrated by this case, the conservative application of those forms and resistence of amendment thereto, based exclusively upon an analysis of diligence, violates FRCP 83(a)(2), which states,

> a local rule imposing a requirement of form shall not be enforced in a manner that causes a party to lose rights because of a non-willful failure to comply with the requirement.

Further, since contentions are a form to augment the pleading, the conservative application by the Northern California District Court and the Federal Circuit is inconsistent with notice pleading represented in Rule 8(a), thus violating FRCP 83(a)(1). Local rules and standing orders cannot modify the notice pleading requirements of the FRCP [see: *Akos Swierkiewicz v. Sorema N.A.* (2002) 534 U.S. 506; 122 S. Ct. 992, 152 L. Ed. 2d 1; *Jones v. Bock* (2007) 127 S. Ct. 910; 166 L. Ed. 2d 798].

The predisposition to allow cases to be tried upon the merits, as opposed to being dismissed upon a technicality is reflected in FRCP 15(b), allowing amendment of pleadings according to proof.

> . . . If evidence is objected to at the trial on the ground that it is not within the issues made by the pleadings, the court may allow the pleading to be amended and shall do so freely when the presentation of the **merits** of the action will be observed thereby and the objecting party fails to satisfy the court that the admission of such evidence would **prejudice** the party . . . [F.R.C.P. 15(b), (emphasis added); *see Foman v. Davis* (1962 371 U.S. 178, 182; 83 S. Ct. 227; 230]

This case arises from alleged infringement of a patent on a snowboard binding. Unlike all other snowboard bindings, the patent reflects a binding that can be adjusted by rotation of the foot, without tools, while the snowboarder is still attached to the snowboard. Thus one can adjust the angle of the rider's foot without a screwdriver, without taking the rider out of the binding. This innovation was particularly beneficial to snowboard rental shops who seek efficiency in modification of the stance of novice snowboarders. The accused devise, developed after Rossignol representatives photographed plaintiffs' binding at a trade show, likewise accomplishes the same innovation.

The principle aspect of the patent claims in question require the upper attachment, i.e. the boot and attached portions of the binding to rotate relative to the lower attachment, i.e. the board and the attached portions of the binding to the snowboard. In the preliminary infringement

contentions, plaintiff mistakenly characterized part of the coupling device of the accused binding as part of the lower attachment. Thus, even though simple observation of the accused devise revealed the upper attachment i.e. the boot and the portion of the binding attached thereto, rotating relative to lower attachment i.e. the snowboard and the portion of the binding attached thereto, the erroneous inclusion of a part of the coupl ıg of the accused device denominated by a number in a box as corresponding to the claim that described the lower attachment, meant that plaintiff did not describe the upper attachment as rotating relative to the lower attachment. Such a mistaken characterization would obviously defeat the infringement claim.

Plaintiffs' case was filed in June 2006. Plaintiffs' issued a claims chart setting forth their preliminary infringement contentions, including the erroneous designation of the coupling device, on January 4, 2006. Recognizing the impact of the erroneous disclosure, defendants quickly moved for summary judgment before a "*Markman*" hearing, where the Court would construe disputed claim terms, could be held [*Markman v. Westview Instruments Inc.*, (*Supra*)]. In responding to the motion for summary judgment, plaintiffs identified their error and disclosed their intent to amend the infringement contentions correcting the error on March 14, 2006, followed by a motion for leave to amend the contentions on March 27, 2006, 34 days following the motion for summary judgment, and 86 days following the initial disclosure containing the error. The Court concluded that plaintiffs' were not diligent in correcting the mistake, denied the motion for leave to amend the contentions, and accordingly, granted the motion for summary judgment. Notwithstanding the observation that no prejudice was occasioned to the defendant, Rossignol, other than having

early filed its motion for summary judgment, plaintiffs were denied an adjudication on the merits. There was no comparison of plaintiffs' claims to the accused device, independent of the erroneous claims chart.

Prejudice or the lack thereof to the non-moving party is a material element to be considered by courts in determining whether to deprive a party of trial on the merits of its case when moving for excuse from neglect [see: *Pioneer Investment Services Co. v. Brunswick* (1993) 507 U.S. 380, 395; 113 S. Ct. 1489; 123 L. Ed. 2d 74]. This Court has recently held that deviation from principles of federal notice pleading is not permitted absent an act of Congress [*Akos Swierkiewicz v. Sorema N.A.* (2002) 534 U.S. 506, 122 S. Ct. 992; 152 L. Ed. 2d 1; and *Jones v. Bock* (2007) 127 S. Ct. 910; 166 L. Ed. 2d 798, (2007) U.S. Lexis 1325].

The conservative application of local patent rules of the Northern District of California (the geographic heart of American innovation), by the District Court and approved for nationwide application by the Federal Circuit Court of Appeals, in *O2 Micro International Limited v. Monolithic Power Systems, Inc.*, (Fed. Cir. 2006) 467 F.3d 1355, contrary to long established principle, deprived plaintiffs of trial on the merits of their case. It violates FRCP 83(a)(2), specifically barring the deprivation of a parties rights due to a non-willful failure to comply with a requirement of form. The deprivation of plaintiffs' rights, notwithstanding a dearth of prejudice to the defense, is contrary to the spirit and the letter of the Federal Rules of Civil Procedure. The policy holds plaintiffs to an improper standard in attempting to hurdle summary judgment motions brought under Rule 56, which are supposed to require the Court to consider evidence, not pleadings, in determining whether a plaintiff's claim can

survive [*Celotex v. Catrett* (1986) 477 U.S. 317, 324; 106 S. Ct. 2548; 91 L. Ed. 2d 265].

Liberal rules of amendment pursuant to FRCP 15(a) and (b) should be applied when the evidence presented to the Court indicates that the mere misidentification of a component part of an infringing devise in the infringement contentions wrongly changed the outcome of the summary judgment motion. Patent claims, just like all other federal causes of action, should be determined on the basis of evidence readily ascertainable by the Court, not on the basis of a mistaken contention by counsel. Failing to consider whether the mistake of counsel has prejudiced the defense is failing to exercise discretion at all. The result is to deprive plaintiffs of meritorious patent infringement lawsuits on mere local rule technicality, reflected in required disclosure forms. The practice, as followed here, works a specific hardship on individual inventors and entrepreneurs who must contend through modest means against the "well heeled" litigation coffers of established corporate infringers. The policy of the Northern District of California, condoned by the Federal Circuit, is being adopted by other districts, and will serve only to promote injustice and classism, favoring the rich establishment, and condoning the usurpation of the individual innovation that has fostered American preeminence in world technology.

This case presents a uniquely pointed circumstance of the injustice of ruling against a plaintiff's claim based upon the mis-identification of one component of the infringing device, sought to be changed before adjudication by summary judgement, factually apparent to be a mistake, with the only prejudice to the defense that they would be deprived of the wrongful defense of a meritorious infringement claim by not being able to seize upon the mistake of plaintiffs' counsel.

CONCLUSION

Accordingly, Petitioners request that the Petition be granted.

Respectfully submitted,

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APPENDIX A — JUDGMENT OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DATED JANUARY 12, 2007 AND FILED JANUARY 16, 2007

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2006-1431

RICHARD W. BERGER and BRANT W. BERGER,

Plaintiffs-Appellants,

v.

ROSSIGNOL SKI COMPANY, INC.,

Defendant-Appellee.

JUDGMENT

ON APPEAL from the UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF CALIFORNIA

in CASE NO(S). 05-CV-02523

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

Per Curiam (MICHEL, *Chief Judge*, GAJARSA, and DYK, *Circuit Judges*):

AFFIRMED. *See* Fed. Cir. R. 36.

Appendix A

ENTERED BY ORDER OF
THE COURT

DATED: JAN 12 2007

s/ Jan Horbaly
Jan Horbaly
Clerk

APPENDIX B — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF CALIFORNIA DENYING MOTION TO VACATE AND DISMISSING COUNTERCLAIMS AS MOOT DATED JULY 16, 2006

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

No. C 05-2523 CRB

RICHARD W. BERGER and BRANT W. BERGER,

Plaintiffs,

v.

ROSSIGNOL SKI COMPANY, INC.,

Defendant.

ORDER DENYING MOTION TO VACATE AND DISMISSING COUNTERCLAIMS AS MOOT

By Memorandum and Order filed April 25, 2006, the Court granted defendant's motion for summary judgment of non-infringement and entered judgment against plaintiffs. Now pending before the Court is plaintiffs' motion to vacate the judgment pursuant to Federal Rule of Civil Procedure 60(b). After carefully considering the papers filed by the parties, the Court concludes that oral argument is unnecessary, *see* Local Rule 7-1(b), and DENIES plaintiffs' motion.

Appendix B

Plaintiffs have not persuaded the Court that it committed "clear error" within the meaning of Rule 60(b)(6). *See Gagan v. Sharar*, 376 F.3d 987, 992 (9th Cir. 2004). First, the Court was not mistaken that plaintiffs had identified 5B, 17 *and* 4 as the lower attachment. Plaintiffs' infringement contentions describe "a lower attachment connectable to a board" as "5B, 4, 17 connectable to board 2." This disclosure cannot reasonably be read as 5B, or 17, or 4. And the disclosure of all three components as the "lower attachment" in claim 1 is consistent with the fact that disc 5B holds components 4 and 17 to the snowboard.

Moreover, prior to their motion to vacate, plaintiffs have never argued that their disclosures did not identify 5B, 4 and 17 together as the lower attachment in claim 1, or even that there was any ambiguity in their contentions. A court does not commit clear error by failing to consider an argument that the movant never made. *See Glavor v. Shearson Lehman Hutton, Inc.*, 879 F.Supp. 1028, 1033 (N.D. Cal. 1994) (citing *Backlund v. Barnhart*, 778 F.2d 1386, 1388 (9th Cir. 1985)); *see also Keenan v Allen*, 91 F.3d 1275, 1279 (9th Cir. 1996) (holding that it is not the district court's task "to scour the record in search of a genuine issue of triable fact;" courts "rely on the nonmoving party to identify with reasonable particularity the evidence that precludes summary judgment") (internal quotation marks and citation omitted). Indeed, far from arguing that their infringement contentions could be read as not including component 4 as part of the lower attachment, plaintiffs admitted that their "original claim chart erroneously stated that the rotatable base 4, or coupler base, is part of the lower attachment." Plaintiffs' Opposition to Motion for Summary Judgment at 11.

Appendix B

Second, the Court did not commit clear error in finding that plaintiffs had not shown good cause for amending their contentions. Plaintiffs' assertion that their error was a "minor" mistake rather than a deliberate choice is belied by their conduct. If the disclosure was indeed a minor mistake, a mere typographical error as plaintiffs imply, they should have been aware of the mistake at the latest when defendants moved for summary judgment. Once aware of the mistake, they should have immediately moved for leave to amend their infringement contentions. They did not; instead, they filed a Rule 56(f) motion to continue the summary judgment motion claiming they needed discovery to defeat the motion. They made no mention whatsoever of any errors in their preliminary infringement contentions.

Their "minor mistake" argument is also *inconsistent* with the declaration of their counsel, Douglas Allen, submitted in support of their belated motion to amend their infringement contentions. He explains: "[f]ollowing a defense filing of a 'Motion for Summary Judgment', the plaintiffs' retention of additional experienced counsel in the area of patent litigation and further '. . . discovery, evaluation, investigation and/or research . . .', which included evaluation of the physical binding submitted to plaintiffs' counsel through a mutual exchange of the physical bindings between my office and the office of Mr. O'Meara, it became apparent that revision of the preliminary infringement contentions and disclosure of asserted claims needed to be submitted." Docket No. 52, Declaration of Douglas Allen, ¶ 4. This statement is an admission that plaintiffs did not realize their contentions were "in error" until after they conducted additional "discovery, evaluation, investigation and/or research;" in other words,

the description of the lower attachment as encompassing components, 5B, 4 and 17 was not a mistake, but rather a deliberate decision that they did not decide to change until after engaging in further inquiry.

Plaintiffs' attempt to explain their delay by stating that they believed they could amend without leave of court after claim construction is unreasonable and unpersuasive. The Patent Local Rules provide that a party may amend its preliminary infringement contentions without leave of court within 30 days of receiving the court's claim construction order *only if* the party believes in good faith that the claim construction ruling or the documents served with preliminary invalidity contentions require amendment. Patent Local Rule 3-6(a). Neither of those exceptions applies to the circumstances alleged by plaintiffs. The Rules are clear that absent those two exceptions a party must show good cause for amendment. Patent Local Rule 3-7.

Finally, that plaintiffs' counsel telephoned defense counsel after plaintiffs filed their Rule 56(f) motion (but before the Court ruled) to advise counsel that plaintiffs wanted to move to amend their preliminary infringement contentions does not make the Court's findings erroneous. The telephone call does not dispute that plaintiffs did not indicate that they wanted to amend their preliminary infringement contentions until after filing a Rule 56(f) motion that did not mention any purported mistake. Nor does it dispute that they did not file a motion to amend their contentions until after this Court denied their Rule 56(f) motion. Moreover, counsel's declaration as to the telephone call does not indicate that counsel advised defense counsel

that plaintiffs wanted to amend their contentions to correct a mistake with respect to the "lower attachment" limitation. *See* Plaintiffs' Motion to Vacate at 12.

Nor have plaintiffs persuaded the Court that the judgment should be vacated because of counsel's "excusable neglect." Fed. R. Civ. P. 60(b)(1). The determination of whether a party has shown excusable neglect is an equitable one, taking into account all the circumstances, including prejudice to the nonmoving party, the length of the delay and its potential impact on judicial proceedings, the reason for the delay, and whether the movant acted in good faith. *See Briones v. Riviera Hotel & Casino*, 116 F.3d 379, 381 (9th Cir. 1997) (citing *Pioneer Inv. Servs. Co. v. Brunswick Assoc. Ltd. Partnership*, 507 U.S. 380 (1993)). As the Court's findings in its April 25, 2006 Memorandum and Order and this Order demonstrate, all of these factors militate against a finding of excusable neglect. It bears repeating that plaintiffs' assertion of an "inadvertent" mistake is contradicted by the sequence of events as well as the declaration of their own counsel. At the time plaintiffs moved to amend, counsel declared that it did not become apparent that the contentions needed to be amended until after plaintiffs received defendants' motion for summary judgment *and* retained additional counsel *and* conducted further discovery, investigation and/or research, including evaluation of the physical binding. Allen Decl. ¶ 4. In other words, only after they realized their original theory of infringement would fail did they decide that they needed to amend their contentions. Such conduct is not excusable neglect.

Appendix B

Plaintiffs' other arguments do not merit discussion. Plaintiffs' motion to vacate is DENIED As the Court held that defendant's device does not infringe as a matter of law, defendant's invalidity and equitable estoppel counterclaims are dismissed as MOOT.

IT IS SO ORDERED.

Dated: July 16, 2006

s/ Charles R. Breyer
CHARLES R. BREYER
UNITED STATES DISTRICT JUDGE

APPENDIX C — MEMORANDUM AND ORDER OF THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF CALIFORNIA DATED APRIL 25, 2006

IN THE UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF CALIFORNIA

No. C 05-02523 CRB

RICHARD W. BERGER and BRANT W. BERGER,

Plaintiffs,

v.

ROSSIGNOL SKI COMPANY, INC.,

Defendant.

MEMORANDUM AND ORDER

Plaintiffs Richard W. Berger and Brant W. Berger bring this suit for patent infringement against defendant Rossignol Ski Company. Plaintiffs' complaint alleges that certain snowboard bindings manufactured and sold by Rossignol Ski Company infringe plaintiffs' U.S. Patent Nos. 5,913,530 (Filed June 16, 1997) and 6,196,569 (Filed April 23, 1999).

Now before the Court is defendant's motion for summary judgment of unenforceability, noninfringement, and invalidity. Because plaintiff only asserts claims from the '530 in their preliminary infringement contentions, only the '530 is in issue. Also before the Court is plaintiffs' cross motion for summary judgment of infringement and plaintiffs' motion

for leave to amend plaintiffs' preliminary infringement contentions to correct alleged errors in infringement contentions for the '530 and to add infringement contentions for the '569.

The critical issue is whether plaintiffs have shown good cause for amending their infringement contentions. Because the Court concludes that plaintiffs have not, their motion to amend must be denied and defendant's motion for summary judgment of noninfringement of the '530 must be granted.

BACKGROUND

A. Pre-filing Background

Plaintiffs first contacted defendant regarding plaintiffs' invention in April 1998. At that time, plaintiffs advised defendant of plaintiffs' International PCT Publication No. WO 97/49464, and stated "the claimed subject matter of the PCT application presents an issue of potential infringement" with respect to a rotatable step-in binding that had recently been introduced by the "Rossignol Group," which included defendant. Plaintiffs sought a meeting with defendant to discuss a possible collaboration. Defendant responded that it did not infringe plaintiffs' patent rights and further that the claims of the PCT application could not be allowed by the United. States Patent and Trademark Office over prior art; nonetheless, defendant agreed to meet with plaintiffs.

Plaintiffs met with defendant in July 1998, and provided defendant with some samples for consideration. In October 1998, defendant wrote Richard Berger and indicated defendant would not use plaintiffs' designs.

Appendix C

In March 1999, plaintiffs notified defendant that plaintiffs' pending patent application was allowed by the patent office and sought another meeting to discuss the situation. Defendant met with plaintiffs and, after reviewing plaintiffs' allowed claims, notified plaintiffs that defendant intended to continue with its own design.

Plaintiffs again wrote to defendant, alleging that defendant possibly infringes plaintiffs' patent and advising defendant to determine whether it needed a license. Defendant reiterated its belief that it did not infringe plaintiffs' patent and, along with sending plaintiffs a sample of its accused product, defendant provided a detailed explanation as to why defendant's accused product did not infringe plaintiffs' patent.

Plaintiffs did not contact defendant again until after they filed this lawsuit in June 2005.

B. Post-filing Background

This Court held a case management conference on November 18, 2005. In accordance with Patent Local Rules 3-1 and 3-2, plaintiffs' preliminary infringement contentions were due 10 days after the conference. Plaintiffs, however, failed to serve their contentions, even after defendant repeatedly asked them to do so. Only after defendant moved to dismiss for failure to prosecute this action, or in the alternative to compel production of plaintiffs' preliminary infringement contentions, did plaintiffs provide the contentions. These contentions were filed more than five weeks after they were due, and then they only contained

infringement contentions for one of the two patents in suit, and only accused defendant of literal infringement. As a result of plaintiffs' submission defendant withdrew its motion to dismiss.

Based on these infringement contentions, defendant filed its invalidity contentions in accordance with Patent Local Rule 3-3 on February 17, 2006. Four days later defendant filed its motion for summary judgment now before this Court. At plaintiffs' request, the original March 31 hearing date on the motion for summary judgment was continued to April 14.

Plaintiffs' new co-counsel of record, Mr. Slobodin, made an appearance as co-counsel on March 14, 2006. The next day plaintiffs moved to defer defendant's motion for summary judgment to allow more time for discovery. This Court issued an order on March 21, 2006 denying the motion to defer under Federal Rule of Civil Procedure Rule 56(f) because plaintiffs failed to demonstrate how the information they sought would preclude summary judgment and plaintiffs failed to demonstrate that they exercised due diligence in seeking discovery. In fact, plaintiffs had not sought to take any discovery in the four months following the case management conference.

After the Court denied plaintiffs' motion to defer, plaintiffs notified defendant that they wished to amend their preliminary infringement contentions. As defendant refused to consent to the proposed amendments, plaintiffs filed a motion to amend.

Appendix C

DISCUSSION

Defendant moves for summary judgment of noninfringement of the '530 based on plaintiffs' preliminary infringement contentions. Plaintiffs do not seriously contest that their contentions establish noninfringement; instead, they now assert that the preliminary infringement contentions were in error and they seek leave to amend the contentions. Defendant opposes granting leave to amend, and argues that even under plaintiffs' revised infringement contentions summary judgment is required.

A. Amending Preliminary Infringement Contentions

Patent Local Rule 3-7 allows parties to amend their preliminary or final infringement contentions, "other than expressly permitted in Patent L.R. 3-6 . . . by order of the Court, which shall be entered only upon a showing of good cause." Patent L.R. 3-7. Patent Local Rule 3-6 permits parties to amend their preliminary infringement contentions within 30 days after service of the Court's Claim Construction Ruling if the party in good faith believes that the ruling requires amendment. Patent L.R. 3-6. Because plaintiffs seek to amend outside the context of a claim construction hearing they must show "good cause." *See* Patent L.R. 3-6, 3-7. A determination of whether good cause has been established is within the sound discretion of the trial court. *See MEMC Elec. Materials. Inc. v. Mitsubishi Materials Silicon Corp.*, 420 F.3d 1369, 1380 n.5 (Fed. Cir. 2005).

Although federal courts are generally lenient in allowing parties to amend pleadings, such is not the case with

amending preliminary infringement contentions. *See LG Electronics, Inc. v. O-Lily Computer, Inc.*, 211 F.R.D. 360, 367 (N.D. Cal. 2002). The patent rules are designed to avoid "vexatious shuffling of positions" that could occur if the parties are permitted to freely modify their infringement contentions at any point in the action. *JSR Corp. v. Tokyo Ohka Kogyo Co.*, 2001 U.S. Dist. LEXIS 24959 *18 (N.D. Cal. Sep. 13, 2001). In *LG Electronics* the court stated:

> The patent local rules were adopted by this district in order to give claim charts more "bite." The rules are designed to require parties to crystallize their theories of the case early in the litigation and to adhere to those theories once they have been disclosed. . . . Unlike the liberal policy for amending pleadings, the philosophy behind amending claim charts is decidedly conservative, and designed to prevent the "shifting sands" approach to claim construction.

Id. at 367 (quoting *Atmel Corp. v. Information Storage Devices, Inc.*, 1998 U.S. Dist. LEXIS 17564 (N.D. Cal. 1998)). Since *Atmel*, the Patent Local Rules have been amended to add Patent Local Rule 3-6, which permits amending infringement contentions after a claim construction ruling. Commenting on the addition of L.R. 3-6, the court in *LG Electronics* stated: "[a]lthough the Patent Local Rules have since been amended to make it somewhat easier to amend claim charts, the general philosophy behind the Patent Local Rules remains as stated in *Atmel*." *Id.* This Court agrees that the Patent Local Rule's "good cause" standard remains more conservative than the lenient standard for amending pleadings.

Appendix C

Plaintiffs rely on the declaration of their counsel, Mr. Allen, to establish grounds for amendment. Mr. Allen declares: "I believe I made errors in the preliminary contentions. The infringement contentions were belated in their production due to having to obtain information from distant locations around this and other states, and in reviewing this information, I neglected to include any claims from the '5.30 Patent." Allen Declaration, Docket 52, ¶ 3. Mr. Allen also claims that he qualified his preliminary infringement contentions with the statement that they were "subject to revision by plaintiffs based on additional discovery, evaluation, investigation and/or research." *Id.* at ¶ 4. Finally, Mr. Allen states: "[f]ollowing a defense filing of a 'Motion for Summary Judgment', the plaintiffs' retention of additional experienced counsel in the area of patent litigation and further '. . . discovery, evaluation, investigation and/or research . . .', which included evaluation of the physical binding submitted to plaintiffs' counsel through a mutual exchange of the physical bindings between my office and the office of Mr. O'Meara, it became apparent that revision of the preliminary infringement contentions and disclosure of asserted claims needed to be submitted." *Id.*

Mr. Allen's declaration does not establish "good cause." First, plaintiffs offer no explanation as to why the "errors" were made in the first place, and, in particular, how they could have "mistakenly" omitted any contentions as to the '569. Mr. Allen's claim that the contentions were late because they had to obtain information "from distant locations around this and other states" does not explain the errors, and, in any event, also does not adequately explain the delay. Mr. Allen does not identify what information

plaintiffs needed to gather; nor does he explain how that information was used in the contentions. This omission is especially glaring given that plaintiffs first accused defendant of infringement more than seven years ago. And they filed this lawsuit in June 2005. Plaintiffs have had more than adequate time to develop their infringement contentions.

Second, plaintiffs' assertion that they "qualified" their contentions by stating that they were subject to revision is immaterial; a party cannot unilaterally amend the Patent Local Rules.

Third, plaintiffs did not diligently seek to amend their contentions. Plaintiffs should have become aware of the alleged errors, and in particular, the omission of any contentions as to the '569, when defendant served its preliminary invalidity contentions; yet, plaintiffs did not notify defendant or the Court of any alleged errors at that time. Even if plaintiffs only became aware of the alleged errors after defendant filed its summary judgment motion, plaintiffs still did not notify the Court or defendant of any errors; instead, plaintiffs sought leave to amend their contentions only after unsuccessfully moving the Court to continue the summary judgment motion on the ground that they needed to take discovery. Their Rule 56(f) motion made no mention of any alleged errors. This sequence of events suggests that the motion to amend is a last-ditch effort to stave off summary judgment rather than a motion based on an honest mistake.

Fourth, the addition of co-counsel is not good cause. To hold otherwise would mean that a party could avoid the Local

Rules simply by adding a lawyer to the pleadings. Moreover, plaintiffs offer no explanation for why co-counsel was not brought into the case earlier, especially since plaintiffs admit that they were conferring with Mr. Slobodin as early as November 2004.

Finally, defendant would be prejudiced if the Court were to grant plaintiffs' motion for leave to amend. Defendant has relied on plaintiffs' preliminary infringement contentions for the past three months. Based on these contentions, defendant incurred substantial costs in creating its preliminary invalidity contentions and the costs associated with preparing their motion for summary judgment. Moreover, permitting amendment will further delay resolution of this case, which has already been delayed due to plaintiffs' unwillingness to comply with the Local Rules.

Plaintiffs' reliance on *ZiLog, Inc. v. Quicklogic Corp.*, 2006 U.S. DIST. Lexis 12844 (N.D. Cal. March 6, 2006) is misplaced. In *ZiLog*, the district court granted a motion to amend preliminary infringement contentions under the "good cause" standard where "effectively" three months had passed since plaintiffs had served the preliminary infringement contentions: *Id.* at *2 In fact, eight days after the preliminary infringement contentions were served the action was stayed. *Id.* Over the next year and a half, the patent office reexamined and invalidated several claims in the suit and the plaintiff had appealed the patent office's decision to the Board of Patent Appeals and Interference, which was still pending at the time of the motion to amend. *Id.* Plaintiff moved to lift the stay and *at the same time* provided notice in the parties' Joint Case Management Statement that it sought to amend

its preliminary infringement contentions. *Id.* Referencing its prior notice, plaintiff filed their motion to amend two months later. *Id.* Defendant had not filed a summary judgment motion or even filed preliminary invalidity contentions at the time of the motion to amend. *See id.* Thus, because the action was stayed during part of the delay, because plaintiff provided timely notice to defendant in relation to the timing of the motion to lift the stay, because plaintiff sought to amend based not on its own error but on the result of PTO reexamination, and because the defendants would not be prejudiced, the court granted leave to amend.

Unlike in *ZiLog*, plaintiffs here failed to promptly amend their preliminary infringement contentions. Waiting one month after defendant filed its motion for summary judgment, on top of the two months since serving their infringement contentions, on top of filing the preliminary infringement contentions more than five weeks late, does not amount to promptly seeking to amend. Further, unlike *ZiLog*, plaintiffs fail to assert any of the common factors that reasonably contribute to a finding of "good cause." Plaintiffs fail to provide any explanation for the original error or why it took nearly three months to discover and seek to correct the error. This delay suggests that the omission of any contentions as to the `569 and the contentions as to the '530 were not "errors," but were instead a deliberate strategic course which plaintiffs now wish to change.

In any event, giving plaintiffs the benefit of the doubt, the most they have established is that their counsel (who is still counsel of record) mishandled this case. Carelessness or mere errors, however, are insufficient to establish good

cause. *See Johnson v. Mammoth Recreations*, 975 F.2d 604, 609 (9th Cir. 1992)(holding that carelessness does not amount to "good cause" in the context of Federal Rule of Civil Procedure Rule 16(b)).

Because plaintiffs have failed to establish "good cause" to amend their preliminary infringement contentions, plaintiffs' motion for leave to amend must be denied. Even if plaintiffs were found to have promptly sought leave to amend they still fail to satisfy this district's good cause standard as they have not provided any justification for the amendment, other than mere error. In fact, plaintiffs offer so little explanation that to permit amendment here would render the "good cause" requirement meaningless.

B. Noninfringement

Having denied plaintiffs' motion to amend their preliminary infringement contentions the Court turns to the issue of literal infringement.

To determine infringement, the asserted claim must be compared to the allegedly infringing device. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995). For a device to literally infringe a patent, every claim limitation, or claim element, must be found in the device. *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 29, 40 (1997). Thus, establishing that the accused device does not satisfy one claim limitation requires a finding of noninfringement. *Id.*; *see also Mas-Hamilton Group v. La Gard, Inc.*, 156 F.3d 1206, 1211 (Fed. Cir. 1998) ("If even one limitation is missing or not met as claimed, there is no literal infringement.").

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Claim 1 of the '530 provides:

1. A binding, comprising:

a boot comprising an upper attachment,

a lower attachment connectable to a board,

a coupler attached to one of said upper and lower attachments, and

a coupling mount attached to the other of said upper attachments, the coupling mount and the coupler being configured to automatically engage with each other to lock the upper attachment to the lower attachment when a user wearing the boot steps onto the lower attachment and to permit *rotation of the upper attachment relative to the lower attachment* when the upper attachment is locked to the lower attachment without release of said upper attachment from said lower attachment.

Claim 1 requires, among other things, "rotation of the upper attachment relative to the lower attachment." '530 Patent, col. 10:31-32. Plaintiffs' original infringement contentions and supporting illustrations label "plate 3" as the "upper attachment" satisfying the "a boot comprising an upper attachment" limitation of clam 1 of the '530 Patent. Plaintiffs label "5B, 4, 17 connectable to board 2" as the "lower attachment" satisfying the "a lower attachment connectable to the board" claim limitation, although plaintiffs' illustrations accompanying their infringement

contentions do not identify anything on the accused device as "17." In any event, it is undisputed that plate 3—the upper attachment—does not rotate *relative* to what plaintiffs' identify as the lower attachment; rather, the upper attachment rotates *with* the lower attachment. Accordingly, under plaintiffs' infringement contentions defendant's accused device does not read on at least one limitation of claim 1 of the `530 and therefore does not infringe as a matter of law. Further, because all asserted claims other than claim 1 are dependent claims of claim 1, the accused device infringes no other claims of the `530 Patent.

Plaintiffs all but admit noninfringement based on their original infringement contentions. Plaintiffs state:

> Defendant's noninfringement argument that accused binding is "missing the 'rotation of the upper attachment relative to the lower attachment' limitation," . . . is based on an error in Plaintiff[s'] preliminary claim chart. In that regard, Plaintiff[s'] original claim chart erroneously stated that the rotatable base 4, or coupler base, is part of the lower attachment. Plaintiffs' referring to the rotatable base, or coupler base, as part of the lower attachment was an error. The rotatable base, our coupler base, is not part of the lower attachment. Under the correct infringement contention, where the coupler base is not part of the lower attachment, the "rotation [o]f the upper attachment relative to the lower attachment limitation" is fulfilled.

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Plaintiffs' Opposition to Motion for Summary judgment, 11. Plaintiffs make no other representation regarding infringement based upon the original infringement contentions; indeed, at oral argument they merely asserted that their original infringement contention is "absurd." As the Court has ruled above, however, plaintiffs have not demonstrated good cause for amending their contentions.

Because it is undisputed that defendant's device does not read on at least one limitation of claim 1 of the '530, defendant's motion for summary judgment of noninfringement of the '530 must be granted and plaintiffs' motion for summary judgment of infringement of the ''530 must be denied.

CONCLUSION

The Patent Local Rules are designed to prevent exactly what plaintiffs are attempting to do here: alter their infringement theory after it became apparent that they were going to lose. As plaintiffs have not shown good cause for amending their preliminary infringement contentions, their motion to amend those contentions is DENIED and defendant's motion for summary judgment of noninfringement of the '530 is GRANTED. Because the Court concludes that defendant's device does not infringe as a matter of law, the Court need not and does not address defendant's claim of invalidity. *See Boss Control, Inc. v. Bombardier Inc.*, 410 F.3d 1372, 1374 (Fed. Cir. 2005). The Court also need not and does not address defendant's equitable estoppel argument. As the '530 is the only patent now at issue in this lawsuit, judgment will be entered in favor of defendant.

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IT IS SO ORDERED.

Dated: April 25, 2006 s/ Charles R. Breyer
CHARLES R. BREYER
UNITED STATES DISTRICT JUDGE

APPENDIX D — RULES INVOLVED

PATENT LOCAL RULES

3. PATENT INITIAL DISCLOSURES

3-1. Disclosure of Asserted Claims and Preliminary Infringement Contentions.

Not later than 10 days after the Initial Case Management Conference, a party claiming patent infringement must serve on all parties a "Disclosure of Asserted Claims and Preliminary Infringement Contentions." Separately for each opposing party, the "Disclosure of Asserted Claims and Preliminary Infringement Contentions" shall contain the following information:

(a) Each claim of each patent in suit that is allegedly infringed by each opposing party;

(b) Separately for each asserted claim, each accused apparatus, product, device, process, method, act, or other instrumentality ("Accused Instrumentality") of each opposing party of which the party is aware. This identification shall be as specific as possible. Each product, device, and apparatus must be identified by name or model number, if known. Each method or process must be identified by name, if known, or by any product, device, or apparatus which, when used, allegedly results in the practice of the claimed method or process;

(c) A chart identifying specifically where each element of each asserted claim is found within each Accused

Instrumentality, including for each element that such party contends is governed by 35 U.S.C. § 112(6), the identity of the structure(s), act(s), or material(s) in the Accused Instrumentality that performs the claimed function;

(d) Whether each element of each asserted claim is claimed to be literally present or present under the doctrine of equivalents in the Accused Instrumentality;

(e) For any patent that claims priority to an earlier application, the priority date to which each asserted claim allegedly is entitled; and

(f) If a party claiming patent infringement wishes to preserve the right to rely, for any purpose, on the assertion that its own apparatus, product, device, process, method, act, or other instrumentality practices the claimed invention, the party must identify, separately for each asserted claim, each such apparatus, product, device, process, method, act, or other instrumentality that incorporates or reflects that particular claim.

3-6. Final Contentions.

Each party's "Preliminary Infringement Contentions" and "Preliminary Invalidity Contentions" shall be deemed to be that party's final contentions, except as set forth below.

(a) If a party claiming patent infringement believes in good faith that (1) the Court's Claim Construction Ruling or (2) the documents produced pursuant to Patent L.R. 3-4 so requires, not later than 30 days after service by the Court of

its Claim Construction Ruling, that party may serve "Final Infringement Contentions" without leave of court that amend its "Preliminary Infringement Contentions" with respect to the information required by Patent L.R. 3-1(c) and (d).

(b) Not later than 50 days after service by the Court of its Claim Construction Ruling, each party opposing a claim of patent infringement may serve "Final Invalidity Contentions" without leave of court that amend its "Preliminary Invalidity Contentions" with respect to the information required by Patent L.R. 3-3 if:

(1) a party claiming patent infringement has served "Final Infringement Contentions" pursuant to Patent L.R. 3-6(a), or

(2) the party opposing a claim of patent infringement believes in good faith that the Court's Claim Construction Ruling so requires.

3-7. Amendment to Contentions.

Amendment or modification of the Preliminary or Final Infringement Contentions or the Preliminary or Final Invalidity Contentions, other than as expressly permitted in Patent L.R. 3-6, may be made only by order of the Court, which shall be entered only upon a showing of good cause.

Appendix D

Rule 83. Rules by District Courts; Judge's Directives

(a) Local Rules.

(1) Each district court, acting by a majority of its district judges, may, after giving appropriate public notice and an opportunity for comment, make and amend rules governing its practice. A local rule shall be consistent with — but not duplicative of — Acts of Congress and rules adopted under 28 U.S.C. §§ 2072 and 2075, and shall conform to any uniform numbering system prescribed by the Judicial Conference of the United States. A local rule takes effect on the date specified by the district court and remains in effect unless amended by the court or abrogated by the judicial council of the circuit. Copies of rules and amendments shall, upon their promulgation, be furnished to the judicial council and the Administrative Office of the United States Courts and be made available to the public.

(2) A local rule imposing a requirement of form shall not be enforced in a manner that causes a party to lose rights because of a nonwillful failure to comply with the requirement.

(b) Procedures When There is Not Controlling Law. A judge may regulate practice in any manner consistent with federal law, rules adopted under 28 U.S.C. §§ 2072 and 2075, and local rules of the district. No sanction or other disadvantage may be imposed for noncompliance with any requirement not in federal law, federal rules, or the local district rules unless the alleged violator has been furnished in the particular case with actual notice of the requirement.

Appendix D

FEDERAL RULES OF CIVIL PROCEDURE

Rule 8. General Rules of Pleading

(a) Claims for Relief. A pleading which sets forth a claim for relief, whether an original claim, counterclaim, cross-claim, or third-party claim, shall contain (1) a short and plain statement of the grounds upon which the court's jurisdiction depends, unless the court already has jurisdiction and the claim needs no new grounds of jurisdiction to support it, (2) a short and plain statement of the claim showing that the pleader is entitled to relief, and (3) a demand for judgment for the relief the pleader seeks. Relief in the alternative or of several different types may be demanded.

(b) Defenses; Form of Denials. A party shall state in short and plain terms the party's defenses to each claim asserted and shall admit or deny the averments upon which the adverse party relies. If a party is without knowledge or information sufficient to form a belief as to the truth of an averment, the party shall so state and this has the effect of a denial. Denials shall fairly meet the substance of the averments denied. When a pleader intends in good faith to deny only a part or a qualification of an averment, the pleader shall specify so much of it as is true and material and shall deny only the remainder. Unless the pleader intends in good faith to controvert all the averments of the preceding pleading, the pleader may make denials as specific denials of designated averments or paragraphs or may generally deny all the averments except such designated averments or paragraphs as the pleader expressly admits; but, when the pleader does so intend to controvert all its averments, including averments

of the grounds upon which the court's jurisdiction depends, the pleader may do so by general denial subject to the obligations set forth in Rule 11.

(c) Affirmative Defenses. In pleading to a preceding pleading, a party shall set forth affirmatively accord and satisfaction, arbitration and award, assumption of risk, contributory negligence, discharge in bankruptcy, duress, estoppel, failure of consideration, fraud, illegality, injury by fellow servant, laches, license, payment, release, res judicata, statute of frauds, statute of limitations, waiver, and any other matter constituting an avoidance or affirmative defense. When a party has mistakenly designated a defense as a counterclaim or a counterclaim as a defense, the court on terms, if justice so requires, shall treat the pleading as if there had been a proper designation.

(d) Effect of Failure to Deny. Averments in a pleading to which a responsive pleading is required, other than those as to the amount of damage, are admitted when not denied in the responsive pleading. Averments in a pleading to which no responsive pleading is required or permitted shall be taken as denied or avoided.

(e) Pleading to be Concise and Direct; Consistency.

(1) Each averment of a pleading shall be simple, concise, and direct. No technical forms of pleading or motions are required.

(2) A party may set forth two or more statements of a claim or defense alternately or hypothetically, either in one count

or defense or in separate counts or defenses. When two or more statements are made in the alternative and one of them if made independently would be sufficient, the pleading is not made insufficient by the insufficiency of one or more of the alternative statements. A party may also state as many separate claims or defenses as the party has regardless of consistency and whether based on legal, equitable, or maritime grounds. All statements shall be made subject to the obligations set forth in Rule 11.

(f) Construction of Pleadings. All pleadings shall be so construed as to do substantial justice.

Rule 15. Amended and Supplemental Pleadings

(a) Amendments. A party may amend the party's pleading once as a matter of course at any time before a responsive pleading is served or, if the pleading is one to which no responsive pleading is permitted and the action has not been placed upon the trial calendar, the party may so amend it at any time within 20 days after it is served. Otherwise a party may amend the party's pleading only by leave of court or by written consent of the adverse party; and leave shall be freely given when justice so requires. A party shall plead in response to an amended pleading within the time remaining for response to the original pleading or within 10 days after service of the amended pleading, whichever period may be the longer, unless the court otherwise orders.

(b) Amendments to Conform to the Evidence. When issues not raised by the pleadings are tried by express or implied consent of the parties, they shall be treated in all

respects as if they had been raised in the pleadings. Such amendment of the pleadings as may be necessary to cause them to conform to the evidence and to raise these issues may be made upon motion of any party at any time, even after judgment; but failure so to amend does not affect the result of the trial of these issues. If evidence is objected to at the trial on the ground that it is not within the issues made by the pleadings, the court may allow the pleadings to be amended and shall do so freely when the presentation of the merits of the action will be subserved thereby and the objecting party fails to satisfy the court that the admission of such evidence would prejudice the party in maintaining the party's action or defense upon the merits. The court may grant a continuance to enable the objecting party to meet such evidence.

(c) Relation Back of Amendments. An amendment of a pleading relates back to the date of the original pleading when

(1) relation back is permitted by the law that provides the statute of limitations applicable to the action, or

(2) the claim or defense asserted in the amended pleading arose out of the conduct, transaction, or occurrence set forth or attempted to be set forth in the original pleading, or

(3) the amendment changes the party or the naming of the party against whom a claim is asserted if the foregoing provision (2) is satisfied and, within the period provided by Rule 4(m) for service of the summons and complaint, the party to be brought in by amendment (A) has received such notice of the institution of the action that the party will not

be prejudiced in maintaining a defense on the merits, and (B) knew or should have known that, but for a mistake concerning the identity of the proper party, the action would have been brought against the party.

The delivery or mailing of process to the United States Attorney, or United States Attorney's designee, or the Attorney General of the United States, or an agency or officer who would have been a proper defendant if named, satisfies the requirement of subparagraphs (A) and (B) of this paragraph (3) with respect to the United States or any agency or officer thereof to be brought into the action as a defendant.

(d) Supplemental Pleadings. Upon motion of a party the court may, upon reasonable notice and upon such terms as are just, permit the party to serve a supplemental pleading setting forth transactions or occurrences or events which have happened since the date of the pleading sought to be supplemented. Permission may be granted even though the original pleading is defective in its statement of a claim for relief or defense. If the court deems it advisable that the adverse party plead to the supplemental pleading, it shall so order, specifying the time therefor.

Rule 83. Rules by District Courts; Judge's Directives

(a) Local Rules

(1) Each district court, acting by a majority of its district judges, may, after giving appropriate public notice and an opportunity for comment, make and amend rules governing its practice. A local rule shall be consistent with—but not

duplicative of—Acts of Congress and rules adopted under 28 U.S.C. §§ 2072 and 2075, and shall conform to any uniform numbering system prescribed by the Judicial Conference of the United States. A local rule takes effect on the date specified by the district court and remains in effect unless amended by the court or abrogated by the judicial council of the circuit. Copies of rules and amendments shall, upon their promulgation, be furnished to the judicial council and the Administrative Office of the United States Courts and be made available to the public.

(2) A local rule imposing a requirement of form shall not be enforced in a manner that causes a party to lose rights because of a nonwillful failure to comply with the requirement.

(b) Procedures When There is No Controlling Law. A judge may regulate practice in any manner consistent with federal law, rules adopted under 28 U.S.C. §§ 2072 and 2075, and local rules of the district. No sanction or other disadvantage may be imposed for noncompliance with any requirement not in federal law, federal rules, or the local district rules unless the alleged violator has been furnished in the particular case with actual notice of the requirement.

Supreme Court, U.S.
FILED
JUN 15 2007
OFFICE OF THE CLERK

No. 06-1372

IN THE

SUPREME COURT OF THE UNITED STATES

RICHARD W. BERGER AND BRANT W. BERGER,

Petitioners,

v.

ROSSIGNOL SKI COMPANY, INCORPORATED,

Respondent

On Petition for a Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

BRIEF IN OPPOSITION

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RULE 29.6 CORPORATE DISCLOSURE STATEMENT

The parent corporations of Respondent Rossignol Ski Company, Inc. are Quiksilver Americas, Inc. and Quiksilver, Inc. Respondent is 100% owned by Quiksilver Americas, Inc., which in turn is 100% owned by Quiksilver, Inc., a publicly traded company.

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OPINIONS AND ORDERS BELOW

The January 12, 2007 Judgment (Order of Affirmance) of the Court of Appeals for the Federal Circuit (Pet. App. A) is reported at 2007 WL 200935. The March 21, 2006, April 25, 2006 and July 16, 2006 Orders/Opinions of the U.S. District Court for the Northern District of California (A732-35 and Pet. App. C and B) are reported at 2006 WL 708943, 2006 WL 1095914 and 2006 WL 2038324, respectively.[1]

INTRODUCTION: SUMMARY OF REASONS FOR DENYING THE PETITION

This case does not merit review, and the Petition should therefore be denied, for at least four reasons.

First, the Petition does not present any compelling reason for review on certiorari as required by this Court's Rule 10. Rather, the Petition merely alleges that the district court's application of its Patent Local Rule requirements with respect to patent infringement contentions deprived Petitioners (supposed "modest means inventors") of a patent infringement trial, a misguided allegation that could be made in any case decided before trial.

Second, the arguments relied upon in the Petition were not raised below and are therefore waived. More particularly, Petitioners did not argue, before the district court or the Federal Circuit, alleged conflict between Judge Breyer's application of the district court's Patent Local Rules and Fed. R. Civ. P. 8, 15(b) and 83(a)(2).

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[1] "Pet." or "Petition" refers to the Petition for a Writ of Certiorari. "A__" refers to the Joint Appendix of record before the Court of Appeals for the Federal Circuit.

Third, the alleged rules conflict is non-existent. The Local Patent Rules, and Judge Breyer's application of them in this case, relate to matters that are distinct from -- and thus are not possibly inconsistent with -- the matters addressed by Fed. R. Civ. P. 8, 15(b) and 83(a)(2). The Patent Local Rules address submission and amendment of post-pleading patent infringement contentions, whereas Fed. R. Civ. P. 8 and 15(b) set forth requirements with respect to pleadings (and amendments to pleadings) and Fed. R. Civ. P. 83(a)(2) concerns nonwillful failures to comply with local rules imposing requirements of form. Accordingly, there likewise is no possible violation of Fed. R. Civ. P. 83(a)(1) due to any inconsistency between the local and federal rules, as alleged.

Fourth, the Petition includes numerous misstatements of fact and law. Thus, the Petition does not even present an accurate portrayal of this case for the Court's consideration.

STATEMENT OF THE CASE[2]

There is nothing about this case that warrants this Court's review of the judgment below in favor of Respondent ("Rossignol"). As the following facts of record establish, Petitioners (the "Bergers") belatedly served their infringement contentions, as required by the district court's Patent Local Rules, after having had literally years to deliberate. Rossignol relied upon those infringement contentions in preparing and serving invalidity contentions under the Patent Local Rules and in preparing and filing a motion for summary judgment. Weeks after Rossignol filed its motion, the Bergers moved to amend their infringement

[2] In compliance with this Court's Rule 15.2, the Petition's numerous misstatements of fact and law are addressed here and/or in the Argument portion of this Opposition Brief below.

contentions to avoid summary judgment, but failed to show good cause for doing so. Thus, Judge Breyer correctly denied the motion to amend, granted summary judgment of noninfringement, entered judgment for Rossignol, and confirmed that judgment in the course of denying the Bergers' motion to vacate. The Federal Circuit correctly affirmed. At no time did either court take any action in violation of Fed. R. Civ. P. 8, 15(b) or 83(a)(2), and the Bergers did not so argue until their Petition to this Court.

A. Petitioners Had Years To Develop Their Infringement Contentions

The Bergers first contacted Rossignol in April 1998, alleging Rossignol's use of the Bergers' purported snowboard binding invention leading to U.S. Patents Nos. 5,913,530 and 6,196,569 (530 and 569 patents, respectively). (Pet. App. C, p. 10a; A195-98, ¶¶2-3; A200-01). After a series of letters and meetings between the parties, Rossignol wrote to the Bergers on May 6, 1999, explaining why Rossignol's products would not infringe the Bergers' alleged patent rights and forwarding a sample of Rossignol's products "to make sure that you have a good understanding of our product." (Pet. App. C, pp. 10a-11a; A195-98, ¶¶4-5; A207-37).[3]

The Bergers never responded to Rossignol's May 6, 1999 letter. Rather, on June 21, 2005 (not June 2006 as stated at Pet. 8), after over six years of silence and inaction by the Bergers, the Bergers brought suit against Rossignol in the Northern District of California for alleged infringement of the 530 and 569 patents. (Pet. App. C, p. 11a; A5; A195-98, ¶6).

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[3] The Petition mischaracterizes the origin of Rossignol's accused snowboard binding and the nature of the alleged invention compared to the prior art. *See* Argument Part IV below, ¶¶ 4-5.

Although the Bergers filed this case in June 2005, they did not serve Rossignol until October 4, 2005, more than three months later, after amending their Complaint as a matter of course. (A5; A52-54; A97-101, ¶¶2-3; A195-98, ¶6). On November 18, 2005, District Court Judge Breyer held a case management conference. (Pet. App. C, p. 11a; A7). At the conference, the Bergers' attorney, Mr. Allen (who filed the Petition with this Court), acknowledged that he was behind on some tasks in the case (including, *e.g.*, serving the Bergers' initial disclosures), and indicated to Rossignol's attorneys that he was meeting later that day with other attorneys, including Mr. Slobodin, to discuss matters. (A97-101, ¶10; A665-68, ¶7; A1003-04, ¶2). At Mr. Allen's request, Judge Breyer granted the Bergers leave to amend their Complaint a second time in accordance with Fed. R. Civ. P. 15, which they subsequently did. (A7; A77-80).

According to the district court's Patent Local Rule 3-1 (Pet. App. D), the Bergers' infringement contentions were to be served within 10 days of the case management conference. However, despite repeated requests from Rossignol following the case management conference, the Bergers did not serve their infringement contentions until January 4, 2006, after Rossignol moved to compel them. (Pet. App. C, pp. 11a-12a; A8; A97-101, ¶¶12-15; A602-05, ¶8). Thus, over and above the many months since the case had been filed, and the many years before the case was filed, the Bergers had yet an additional month to prepare and serve their infringement contentions at a time when both Mr. Allen and Mr. Slobodin were involved in the case on behalf of the Bergers.

B. Petitioners' Belated Infringement Contentions Were Detailed And Deliberate

The Bergers' infringement contentions (A239-54) asserted literal infringement (not infringement under the doctrine of equivalents) of independent claim 1 and several dependent claims of the pleaded 530 patent (and no claims of the pleaded 569 patent) by an illustrated Rossignol snowboard binding (the "accused binding"). The Bergers' infringement contentions included various photographs of Rossignol's accused binding, and identified various parts of the binding as allegedly corresponding to elements of the Bergers' asserted claims.

The independent claim asserted by the Bergers recited a binding that included, *inter alia*, "a boot comprising an upper attachment" and "a lower attachment connectable to a board." (A45; A241). The Bergers' infringement contentions explained in detail, with respect to the asserted claims, that (1) the upper attachment in Rossignol's accused binding was a plate fixed to the boot, and (2) the lower attachment in Rossignol's accused binding was an assemblage, connected to the snowboard, including a rotatable base (labeled no. 4 in the Bergers' photographs). (A241-43 and A245). With respect to the rotatable base 4, the Bergers' infringement contentions stated, for example, that "Lower attachment includes 4 ...." (A243).

Thus, Petitioners did not "[p]lac[e] a component number in the wrong box," and thus provide a "mere misidentification of a component part," in their infringement contentions. (Pet. 5, 8, 10). Moreover, Petitioners' infringement contentions did not constitute a "requirement of form" or a "mere local rule technicality." (Pet. 6, 7, 9, 10). Rather, after having had years to deliberate, Petitioners appropriately explained -- in their substantive infringement

contentions -- that Rossignol's binding assemblage connected to the snowboard, including rotatable base 4, constituted the claimed "lower attachment connectable to a board." (A239-54).

C. Rossignol's Invalidity Contentions And Summary Judgment Motion Relied Upon Petitioners' Infringement Contentions

Based in significant part on the Bergers' infringement contentions, Rossignol prepared and served detailed invalidity contentions on February 17, 2006 as required by Patent Local Rule 3-3, and filed and served a motion for summary judgment of unenforceability (equitable estoppel), noninfringement and invalidity on February 21, 2006. (Pet. App. C, p. 12a; A8; A128-58; A1399-1401). In each of these documents, Rossignol specifically pointed out that the Bergers had asserted only certain claims of the 530 patent and no claims of the 569 patent. (A135 n. 1; A1004, ¶3; A1005-07, n. 1).

In response to the request of the Bergers' attorney, Mr. Allen, to move the original March 31 summary judgment motion hearing date in view of Mr. Allen's vacation schedule (which hearing was moved by agreement of the parties to April 14), Mr. Allen and Rossignol's attorneys had several discussions regarding the motion. During this period of time, Mr. Allen did not indicate that the Bergers intended to amend their infringement contentions, and he did not take any action to do so. (Pet. App. C, pp. 12a, 16a; A8-10; A583-84; A665-68, ¶¶2-7).

D. Petitioners' Actions In Response To Rossignol's Summary Judgment Motion

The Bergers' other attorney, Mr. Slobodin, finally filed a formal appearance on March 14, 2006, despite having been involved in the matter since at least November 2005 according to his co-counsel, Mr. Allen. (Pet. App. C, pp. 12a, 16a-17a; A9; A652-53; A665-68, ¶7; A1003-04, ¶2). The Bergers then moved on March 15, 2006 to defer Rossignol's summary judgment motion, based, *inter alia*, on an alleged need for discovery. (A9; A655). On March 21, 2006, Judge Breyer issued an order denying the Bergers' motion to defer, setting an extended briefing schedule on Rossignol's summary judgment motion, and confirming that the summary judgment hearing would go forward on April 14 as scheduled. (Pet. App. C, p. 12a; A10; A732-35). Judge Breyer's order reflected the fact that the Bergers had not sought to take any discovery despite the passage of over four months since the case management conference, and had not specified what discovery was allegedly needed with respect to Rossignol's summary judgment motion. (A733-34). After Judge Breyer denied their motion to defer, the Bergers then filed a motion to amend their infringement contentions and an opposition to Rossignol's summary judgment motion on March 27, 2006. (A10-10A).

In their motion to amend, the Bergers sought to substantially recast their infringement contentions in view of Rossignol's summary judgment motion that had been filed over a month earlier. (Compare A239-54 with A747-54; see also A998-1000). For example, the Bergers proposed, *inter alia*, to newly assert a claim of the 569 patent, change the group of asserted 530 patent claims, assert the doctrine of equivalents, change what they asserted to be the lower attachment in Rossignol's accused binding, reverse what they asserted to be a coupling mount and coupler in Rossignol's

accused binding, and change their positions regarding various ones of the dependent claims. (*Id.*).

The Bergers' primary justification for seeking to amend their infringement contentions was that their attorney who prepared the contentions, Mr. Allen, was "not experienced patent counsel" (A761, ¶1) and "made errors in" the infringement contentions (A762, ¶3; also A736). The Bergers further contended that the need to amend their infringement contentions became apparent after (1) Rossignol filed its summary judgment motion, (2) the Bergers retained additional counsel, Mr. Slobodin, and (3) the Bergers conducted further discovery, evaluation, investigation and/or research, including evaluation of the physical binding. (A762, second ¶4). The Bergers also asserted that amendment was supported by the inclusion in their contentions of a boilerplate qualifying statement that they were subject to revision. (A762, first ¶4).

The Bergers' defense to summary judgment of noninfringement based on one of several missing claim features -- the absence in Rossignol's accused binding of "rotation of the upper attachment relative to the lower attachment" as required by 530 patent claim 1 (Pet. App. C, p. 20a) -- depended upon the Bergers being permitted to amend their infringement contentions. The Bergers stated in their summary judgment opposition brief that, "[u]nder the correct infringement contention, where the coupler base [rotatable base 4] is not part of the lower attachment [contrary to the Bergers' infringement contentions but in accordance with their proposed amended contentions], the 'rotation [o]f the upper attachment relative to the lower attachment limitation' is fulfilled." (Pet. App. C, p. 21a; A797).

E. Judge Breyer's April 25, 2006 Memorandum And Order

1. Denial Of Petitioners' Motion To Amend For Lack Of Good Cause

In ruling on the Bergers' motion to amend on April 25, 2006, Judge Breyer stated that "[t]he critical issue is whether plaintiffs have shown good cause for amending their infringement contentions," as required by Patent Local Rule 3-7. (Pet. App. C, pp. 10a and 13a). Judge Breyer thoroughly considered at least five factors before denying the Bergers' motion to amend for lack of good cause.

First, Judge Breyer thoroughly assessed Mr. Allen's declaration accompanying the Bergers' motion to amend. He determined that Mr. Allen's declaration failed to establish good cause, because it failed to explain why the alleged "errors" were made, how Mr. Allen and his clients could have "mistakenly" omitted any contentions as to the 569 patent, or why they delayed in moving to amend their contentions. (Pet. App. C, pp. 15a-16a). He concluded that Mr. Allen's declaration at most established carelessness or mere errors that were insufficient to establish good cause. (*Id.*, pp. 18a-19a).

Second, Judge Breyer held that the Bergers' boilerplate qualification of their infringement contentions was immaterial. He noted that a party cannot unilaterally amend the Patent Local Rules. (Pet. App. C, p. 16a).

Third, Judge Breyer concluded that the Bergers were not diligent in seeking to amend their infringement contentions. He noted that the Bergers did not move to amend their infringement contentions when the Bergers received Rossignol's invalidity contentions, or even later

when the Bergers received Rossignol's summary judgment motion, but rather waited until after he denied their motion to defer Rossignol's summary judgment motion. (Pet. App. C, p. 16a). He also noted that the Bergers' delay in this regard came on the heels of their several-week delay in filing their infringement contentions following their over seven-year delay in filing suit after first accusing Rossignol of infringement. (*Id.*, pp. 16a and 18a).

Fourth, Judge Breyer held that Petitioners' addition of co-counsel (Mr. Slobodin) did not provide good cause. He noted in this regard that Petitioners had been conferring with Mr. Slobodin for months prior to his formal appearance in the case. (Pet. App. C, pp. 16a-17a).

Fifth, Judge Breyer concluded that Rossignol would be prejudiced if he were to permit the Bergers to amend their infringement contentions. He indicated that Rossignol had relied upon the Bergers' infringement contentions and incurred substantial costs in preparing Rossignol's invalidity contentions and summary judgment motion. He also indicated that permitting amendment would further delay resolution of the case, "which has already been delayed due to plaintiffs' unwillingness to comply with the Local Rules." (Pet. App. C, p. 17a).

Judge Breyer ultimately determined that the Bergers had failed to establish good cause to amend their infringement contentions, even if the Bergers had promptly sought leave to amend the contentions, which they had not. He concluded that "plaintiffs offer so little explanation that to permit amendment here would render the 'good cause' requirement meaningless." (Pet. App. C, p. 19a).

Thus, Judge Breyer did not deny the motion merely because of Petitioners' lack of diligence. (Pet. 8). He also

did not "[f]ail[] to consider whether the mistake of counsel has prejudiced the defense" (Pet. 10), and certainly did not observe that "no prejudice" or "no measurable prejudice" would occur if the motion was granted (Pet. 1, 8-9). Rather, Judge Breyer considered diligence, prejudice and all of the other circumstances consistent with Petitioners' cited case of *Pioneer Investment Services Co. v. Brunswick Assoc. Ltd. Partnership*, 507 U.S. 380 (1993) (Pet. 9), including Petitioners' failures to explain how their alleged errors occurred and to otherwise justify their requested amendment. He then correctly concluded that (1) the Bergers had not shown good cause for amending their infringement contentions and (2) Rossignol would be prejudiced if Petitioners were permitted to amend. (Pet. App. C, pp. 13a-19a; Pet. App. B, pp. 5a-7a).

2. Grant Of Rossignol's Motion For Summary Judgment

In granting summary judgment of noninfringement in Rossignol's favor, Judge Breyer acknowledged that the Bergers pleaded infringement of both the 530 and 569 patents, but asserted in their infringement contentions infringement of only specified claims of the 530 patent and no claims of the 569 patent. (Pet. App. C, p. 9a). With respect to the asserted claims, he considered the Bergers' infringement contentions and accompanying illustrations of Rossignol's accused binding that labeled the boot plate as the "upper attachment" and the assemblage on the snowboard (including rotatable base 4) as the "lower attachment." (*Id.*, pp. 20a-21a). He compared asserted independent claim 1 to Rossignol's accused binding and held that there is no literal infringement because the alleged "upper attachment" in Rossignol's binding does not rotate relative to the alleged "lower attachment" as expressly required by the claim (*i.e.*,

rotatable base 4 rotates with, not relative to, the boot plate). (*Id.*, pp. 19a-22a).

Because the remainder of the asserted claims depend directly or indirectly from claim 1, Judge Breyer also held that the asserted dependent claims are not infringed. (Pet. App. C, p. 21a). His order did not address the doctrine of equivalents because, as noted above, the Bergers' infringement contentions did not assert infringement under the doctrine of equivalents as required by the district court's Patent Local Rule 3-1(d). (*See* A239-54).

The Petition erroneously implies that Judge Breyer did not consider evidence outside the pleadings in ruling on Rossignol's summary judgment motion, and erroneously states that "plaintiffs were denied an adjudication on the merits" because, allegedly, "[t]here was no comparison of plaintiffs' claims to the accused device, independent of the erroneous claims chart." (Pet. 9; *see also* Pet. 1, 7, 10). To the contrary, the parties' summary judgment papers included a total of nearly 40 exhibits, including fact witness declarations and other information relating, *inter alia*, to the issue of infringement/noninfringement. (A8; A10A; A134; A767; A824 and A849). Moreover, in granting summary judgment of noninfringement on the merits, Judge Breyer compared Petitioners' asserted claims to the accused device, while considering the appropriateness of Petitioners' characterization of the accused device in their infringement contentions. (Pet. App. C, pp. 19a-22a; Pet. App. B, p. 4a).

F. Petitioners' Motion To Vacate Judgment And Judge Breyer's July 16, 2006 Order Denying The Motion

On May 23, 2006, nearly a month after Judge Breyer's April 25 order and one day before the Bergers

appealed to the Federal Circuit, the Bergers moved under Fed. R. Civ. P. 60(b) to vacate Judge Breyer's judgment that was based on his April 25 order. (A10D). The Bergers relied upon both old and new arguments (including the general proposition that local court rules must be consistent with the Federal Rules of Civil Procedure), but did not argue a conflict between the district court's application of its Patent Local Rules and Fed. R. Civ. P. 8, 15(b) and 83(a)(2). (A1178-96). On July 16, 2006, after the motion was fully briefed, Judge Breyer denied the motion, thereby confirming his judgment and April 25 order. (Pet. App. B). More particularly, he indicated in his July 16 order, *inter alia*, that "plaintiffs' assertion of an 'inadvertent' mistake is contradicted by the sequence of events as well as the declaration of their own counsel." (*Id.*, p. 7a; *see also* pp. 5a-6a).

G. Petitioners' Federal Circuit Appeal

The Bergers appealed to the Federal Circuit. The Bergers again relied upon both old and new arguments (including the general requirement for consistency between local and federal rules), but did not argue a conflict between the district court's application of its Patent Local Rules and Fed. R. Civ. P. 8, 15(b) and 83(a)(2). (*See* the Bergers' Federal Circuit briefs). After briefing and oral argument, the Federal Circuit (Chief Judge Michel and Circuit Judges Gajarsa and Dyk) affirmed Judge Breyer's judgment. (Pet. App. A).

ARGUMENT: REASONS FOR DENYING THE PETITION

I. The Petition Presents No Compelling Reason For Review On Certiorari As Required By This Court's Rule 10

This Court's Rule 10 reflects "the character of the reasons the Court considers" in reviewing a petition for a writ of certiorari. The instant Petition does not even refer to Rule 10, much less present for the Court's consideration any reason of the magnitude of those set forth in Rule 10 that would warrant this Court's review of this case.

Indeed, the Petition's "Question Presented" (Pet. *i*), like the rest of the Petition, does nothing more than allege that the district court's application of its Patent Local Rule requirements with respect to patent infringement contentions deprived Petitioners of a patent infringement trial, a misguided allegation that could be made in any case decided before trial. This does not amount even to an allegation "of erroneous factual findings or the misapplication of a properly stated rule of law," for which "[a] petition for a writ of certiorari is rarely granted." Supreme Court Rule 10.

Nor does the Petition's purported plea on behalf of "modest means inventors" (Pet. *i*, 3) present a reviewable question for this Court. As explained in the Petition's cited case of *Weibrecht v. Southern Illinois Transfer, Inc.*, 241 F.3d 875, 880 (7th Cir. 2001), the fact that a local rule might impose additional requirements and thereby raise the cost of pursuing a right under a federal law does not present a conflict between the local rule and the federal law. Moreover, at least in *Weibrecht* there was an arguable conflict between the federal law and the local rule there in issue (*i.e.*, the federal law prohibited devices that prevent

common carrier employees from voluntarily furnishing information concerning employee injuries and death, and the local rule required a lawyer to go through such employees' lawyers to obtain such information). By contrast, the Petition in this case does not present even an arguable conflict between federal and local rules, as discussed below.

II. The Petition Relies Upon Arguments That Were Not Raised Below And Are Thus Waived

Although Petitioners generally argued below that local rules must be consistent with the Federal Rules of Civil Procedure, Petitioners did not argue to the district court or the Federal Circuit that the district court's Patent Local Rules, or Judge Breyer's application of them in this case, were allegedly in conflict with Fed. R. Civ. P. 8, 15(b) or 83(a)(2), upon which Petitioners now primarily rely. (*E.g.*, *compare* A1178-96 (motion to vacate judgment) and Petitioners' Federal Circuit briefs with Pet. 3, 6-7). Accordingly, Petitioners' arguments are waived. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ____, 127 S. Ct. 1727, 1744 (2007) ("In light of Teleflex's failure to raise the argument in a clear fashion, and the silence of the Court of Appeals on the issue, we take the District Court's conclusion on the point to be correct."); *Travelers Casualty & Surety Co. of America v. Pacific Gas & Electric Co.*, 127 S. Ct. 1199, 1207 (2007) ("we ordinarily do not consider claims that were neither raised nor addressed below"); *Bath Iron Works Corp. v. Director, OWCP*, 506 U.S. 153, 162 n.12 (1993) ("Petitioners did not raise the issue below and the Court of Appeals considered it waived.... We do as well.").

III. The Petition Relies Upon Irrelevant Arguments That Do Not Present A Conflict Between The District Court's Patent Local Rules And The Federal Rules Of Civil Procedure

The Petition asserts a violation of Fed. R. Civ. P. 83(a)(1) by reason of alleged inconsistency between the district court's Patent Local Rules (and their application) and Fed. R. Civ. P. 8, 15(b) and 83(a)(2). (*E.g.*, Pet. 3 and 6-7). However, the Petition presents no viable example of any such inconsistency. As discussed below, the district court's Patent Local Rules, and Judge Breyer's application of them in this case, relate to matters that are distinct from -- and thus are not possibly inconsistent with -- the matters addressed by Fed. R. Civ. P. 8, 15(b) and 83(a)(2).

A. Fed. R. Civ. P. 83(a)(1)

Fed. R. Civ. P. 83(a)(1) expressly states that "[a] local rule shall be consistent with -- but not duplicative of --" federal rules. Additionally, Fed. R. Civ. P. 83(b) states that "[a] judge may regulate practice in any manner consistent with" both federal and local district court rules.

Those statements describe precisely the district court's Patent Local Rules and their application in this case by District Court Judge Breyer. As discussed below, the Patent Local Rules are consistent with and not duplicative of Fed. R. Civ. P. 8, 15 and 83(a)(2), and Judge Breyer merely regulated practice consistent with both the federal civil rules and the district court's Patent Local Rules. Thus, the Petition presents no possible basis for a violation of Fed. R. Civ. P. 83(a)(1).

B. Fed. R. Civ. P. 83(a)(2)

Fed. R. Civ. P. 83(a)(2) relates to matters of "form" and "technicality," as reflected by its express provisions (and admitted by Petitioners). (Fed. R. Civ. P. 83(a)(2); Pet. 3, 6, 9-10). Moreover, Fed. R. Civ. P. 83(a)(2) is only potentially implicated in the event of a non-willful failure to comply with a requirement of form. (*Id.*). Neither condition exists in this case.

As is evident from even a quick perusal of Patent Local Rule 3-1 (Pet. App. D, pp. 24a-25a), the infringement contentions required by the Patent Local Rules are a matter of substance, not "form" or "technicality" as alleged (but not demonstrated) by Petitioners. (Pet. 6, 7, 9, 10). Infringement contentions are likewise not merely "a vehicle to assist the Court in identifying which claims in the patent apply to the accused infringing device." (Pet. 4). Rather, infringement contentions under the Patent Local Rules serve to provide the district court and the accused infringer with detailed information with respect to a patentee's assertion of infringement. For example, Patent Local Rule 3-1 requires the infringement contentions to (a) identify each patent claim allegedly infringed, (b) separately identify for each asserted claim, "as specific as possible," each accused apparatus, product, device, process, method, act, or other instrumentality, (c) provide a chart identifying specifically where each element of each asserted claim is found within each accused instrumentality, (d) indicate whether asserted infringement is alleged to be literal or under the doctrine of equivalents, (e) identify the priority date to which each asserted claim allegedly is entitled, and (f) identify the patentee's own products, processes, etc. that are allegedly encompassed by the asserted claims. (Pet. App. D, pp. 24a-25a).

The types of things that have been held to be matters of form are minor formatting or procedural requirements, not disclosures of substantive information and positions. Conversely, things even approaching substance *(e.g.*, deadlines and other requirements for opposing summary judgment) have been held not to be matters of form. In this regard, *see, e.g., Cornett v. Weisenburger*, 454 F.Supp.2d 544, 551-52 (W.D. Va. 2006) (local rule requirements to pay filing fee upon filing complaint and to follow precise format for filing by facsimile are matters of form); *El-Kaissi v. Martinaire, Inc.*, 2005 WL 2897055 *6 (S.D. Tex. 2005) ("rules of form are just that - rules that require court submissions to be in a certain form," and thus local rule deadline for filing a response to a summary judgment motion is not a matter of form); *Loggins v. Franklin County*, 2005 WL 1705187 *3 (S.D. Ohio 2005) (deadline for submitting evidence in opposition to summary judgment motion was not a matter of form); and *Cordray v. 135-80 Travel Plaza, Inc.*, 356 F.Supp.2d 1011, 1015 n.6 (D. Neb. 2005) (local rule requirement to authenticate documents offered in opposition to summary judgment motion was not a matter of form).

Additionally, a statement in an infringement contention does not constitute a non-willful failure to comply with the requirement for infringement contentions. Understandably, Petitioners did not (and could not) show otherwise in their Petition.

Thus, Judge Breyer's denial of Petitioners' motion to amend their infringement contentions for lack of a showing of good cause, and his grant of Rossignol's motion for summary judgment of noninfringement based, *inter alia*, upon Petitioners' infringement contentions, did not conflict with the provision in Fed. R. Civ. P. 83(a)(2) that "[a] local rule imposing a requirement of form shall not be enforced in a manner that causes a party to lose rights because of a

nonwillful failure to comply with the requirement." (Emphasis added). Accordingly, Judge Breyer's application of the Patent Local Rules in this case did not violate Fed. R. Civ. P. 83(a)(1) by reason of any inconsistency with Fed. R. Civ. P. 83(a)(2).

C. Fed. R. Civ. P. 8 and 15

Fed. R. Civ. P. 8 governs pleadings, not substantive submissions subsequent to pleadings. Thus, Rule 8 does not govern submission of infringement contentions following a case management conference as required by the district court's Patent Local Rule 3-1.

Likewise, Fed. R. Civ. P. 15 relates to amendments to pleadings, not amendments to substantive submissions such as infringement contentions. Judge Breyer therefore correctly found that Patent Local Rule 3-7, not the "generally lenient" pleading amendment provisions of Fed. R. Civ. P. 15, governed Petitioners' motion to amend their infringement contentions. (Pet. App. C, pp. 13a-14a).

Thus, the district court's Patent Local Rules do not impose requirements with respect to a party's pleadings, but rather impose requirements with respect to a party's post-pleading disclosures. Accordingly, contrary to Petitioners' assertion (Pet. 3, 6-7), Judge Breyer's application of the Patent Local Rules did not conflict with the provisions of Fed. R. Civ. P. 8 or 15 relating to pleadings and amendments to pleadings.[4] For the same reason, the Petition's cited cases of *Swierkiewicz v. Sorema N.A.*, 534 U.S. 506 (2002), and

[4] Indeed, in accordance with Fed. R. Civ. P. 15, Judge Breyer permitted Petitioners to amend their Complaint a second time after they had amended it once before as a matter of course. (A5; A7; A52-54; A77-80).

Jones v. Bock, 549 U.S. ___, 127 S. Ct. 910 (2007) (Pet. 6 and 9), are inapplicable, as both cases addressed issues relating to the sufficiency of complaints (not post-pleading disclosures) given lower courts' impositions of specific pleading requirements over and above those required by Fed. R. Civ. P. 8(a).

IV. The Petition Includes Numerous Additional Misstatements of Fact and Law

In compliance with its obligation under this Court's Rule 15.2, Respondent Rossignol addresses, as follows, the Petition's misstatements of fact and law beyond those addressed above:

1. The Petition mischaracterizes the Federal Circuit's decision in *O2 Micro Int'l Ltd. v. Monolithic Power Systems, Inc.*, 467 F.3d 1355 (Fed. Cir. 2006). The Petition erroneously states with respect to that case that "[i]n reviewing motions for leave to amend infringement contentions, the Federal Circuit has determined that the District Court shall consider only the diligence, or lack thereof, of the moving party [the Bergers in the instant case] without regard to considerations of prejudice to responding party [Rossignol in the instant case]." (Pet. 4). The Federal Circuit merely ruled in *O2 Micro* that, under the specific circumstances at issue in that case, including "O2 Micro's delay in moving to amend its infringement contentions and its lack of adequate explanation for this delay" resulting in the district court's "finding a lack of diligence and therefore a lack of 'good cause,'" the Court saw no need to consider the question of prejudice to Monolithic Power Systems. *Id.* at 1367-68. In any event, the case is irrelevant to the instant case in which Judge Breyer, in ruling on Petitioners' motion to amend their infringement contentions, considered

prejudice and other circumstances in addition to diligence. (*See again* Pet. App. C, pp. 13a-19a; Pet. App. B, pp. 5a-7a).

2. The Petition mischaracterizes this Court's decision in *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), as supposedly requiring "the Court to consider evidence, not pleadings" in conjunction with a summary judgment motion. (Pet. 9-10). As *Celotex* held, in a case such as this where a summary judgment motion is directed to an issue (alleged infringement) as to which the non-moving party (the Bergers) has the burden of proof, "a summary judgment motion may properly be made in reliance solely on the 'pleadings, depositions, answers to interrogatories, and admissions on file.' " *Id.* at 324. The non-moving party (the Bergers) must then go beyond the pleadings to demonstrate a genuine issue for trial, *id.*, which the Bergers did not do in this case.

3. Citing this Court's decision in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), the Petition implies that a separate "*Markman*" claim construction hearing must be conducted. (Pet. 8). This Court's *Markman* decision includes no such requirement. Furthermore, the Federal Circuit's underlying decision, *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 981 (Fed. Cir. 1995) (affirmed by this Court's decision), states that a court may conduct claim construction, *e.g.*, "in the context of dispositive motions such as those seeking judgment as a matter of law."

4. There is nothing in the record to support the Petition statement that Rossignol's accused binding was developed "after Rossignol representatives photographed plaintiffs' binding at a trade show." (Pet. 7). Richard Berger's declaration addressing the trade show in question did not state/contend that Rossignol representatives

photographed the Bergers' binding. (*See* A824-25). Moreover, an uncontested declaration in the record establishes that the company Emery developed the accused binding without any knowledge of the Bergers' binding. (A869-910).

5. The snowboard binding disclosed and claimed in Petitioners' patents is not "[u]nlike all other snowboard bindings" in allegedly being "a binding that can be adjusted by rotation of the foot, without tools, while the snowboarder is still attached to the snowboard." (Pet. 7). The prior art included snowboard bindings that could be adjusted by rotation of the foot, without tools, while the snowboarder remained attached to the snowboard. (*E.g.*, A153-54; A156; A256; A322-88; A390; A401-12; A467-72; A479; A497; A563-66; A920-31 and A933-37).

6. In view of (a) the prior art discussed above, (b) the multiple bases for noninfringement, and (c) the equitable estoppel resulting from Rossignol's reliance upon the Bergers' failure to respond to Rossignol's May 6, 1999 letter coupled with the Bergers' over 6 year delay in filing suit (*see, e.g.*, A141-58 and A852-64 and referenced exhibits), granting of the Bergers' motion to amend their infringement contentions would not "have allowed plaintiff to pursue a meritorious case." (Pet. 2).

CONCLUSION

For the foregoing reasons, the Petition for a Writ of Certiorari should be denied.

June 15, 2007

Respectfully submitted,

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No. 06-1372

IN THE

Supreme Court of the United States

RICHARD W. BERGER and BRANT W. BERGER,

Petitioners,

v.

ROSSIGNOL SKI COMPANY, INCORPORATED,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF

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Northern District of California Local Patent Rules

RULE 56 4

RULE 60(b) 7

Federal Rules of Civil Procedure

FRCP 15(b) 4

FRCP 33(b) 3

FRCP 26(e) 4

Are preliminary infringement contentions, as defined by the local rules of the Northern District of California "substantive" or "procedural". If they are "substantive" as described by Respondent then they take the place of the patent claims themselves, to be applied by the Court to the accused device as done here. If, however, they are "procedural" or a matter of "form", then this case exemplifies an unfair and unlawful application of local rules, which have not only deprived these Petitioners of a valid patent claim, but will continue to plague other plaintiffs, struggling against poor financing and economically superior defendants, and will further mean that patent litigation will be an exception to the long established mandate of American jurisprudence that cases be tried upon the merits. Petitioners contend that such rules are clearly not substantive, but procedural. Because they are procedural and because the Court below disregarded the evidence in exalting form over substance, petitioners were denied a trial of their case upon the merits. A trial upon the merits is doctrine well rooted in American law and found in numerous references replete through the rules and cases. This petition, not only reveals the error of the lower Court, when upon exalting the form of the local rules over the substance of the evidence before it on a motion for summary judgment erroneously ruled in petitioners case, but also reveals a policy of the Northern District of California, setting a trend for other districts [*J.S.R. Corp. v. Tokyo Ohka Kogyo Co.*, 2001 U.S. Dist. Lexis 24959 (N.D. Calif. 2001); *Amtel Corp. v. Information Storage Devices, Inc.*, 1998 U.S. Dist. Lexis 17564 (N.D. Calif. 1998)]. Thus this case represents an important question of Federal law that has not been, but should be settled by this Court (Rule 10). Specifically review of the Federal Circuit's case in *O2 Micro International Limited v. Monolithic Power Systems, Inc.*, (Fed. Cir. 2006) 467 F.3d 1355 and other decisions reveals a developing and dangerous trend to render decisions based upon local rules regarding form as opposed to the merits of claims.

PRELIMINARY INFRINGEMENT CONTENTIONS ARE FORM NOT SUBSTANCE

The role of the Court in determining infringement is a two step analysis.

> first the claims must be correctly construed to determine the scope of the claims. Second, the claims must be compared to the accused device [*Kahn v. General Motors Corp.* (Fed. Cir. 1998) 135 Fed. 3rd 1472, 1476; *Markman v. Westview Instruments Inc.*, (Fed. Cir. 1995) 52 Fed. 3rd 967, 976].

In this case, however, the trial court did not compare the "claims" to the accused device. Rather the trial court compared the "preliminary infringement contentions" to the accused device. The evidence before the trial court demonstrated a different application was appropriate. Appendix "C" to the Petition for a Writ of Certiorari contains the Court's written decision where at page 21(a) the Court states,

> in any event, it is undisputed that plate 3-the upper attachment-does not rotate relative **to what plaintiffs identify as the lower attachment**; rather, the upper attachment rotates with the lower attachment. Accordingly, under plaintiffs' **infringement contentions** defendants accused device does not read on at least one limitation of claim one of the '530 and therefore does not infringe as a matter of law. (emphasis added)

Thus, like respondents, the Court considered the preliminary infringement contentions a matter of substance which take the place of the claims in the patent itself. The Court is obligated to compare the claims to the accused device, not the infringement contentions.

In doing so the Court disregarded the evidence before it. The claims are written in the patent itself and the patent is what constitutes the evidence before the Court. Those claims are to be compared with the accused device. Notwithstanding the preliminary infringement contentions, plaintiff Richard Berger in this declaration filed in response to the motion for summary judgment clearly described the patent claims and how they applied to the accused device, properly identifying the upper attachment and the lower attachment distinguishing those from the coupler (A826-828). In his declaration, Mr. Berger separated the coupler and coupling mount from the lower attachment, thus demonstrating that the upper attachment did rotate relative to the lower attachment in the accused device, fulling the claim, and demonstrating infringement. The declaration presented evidence that contradicted and corrected the mistaken allegation in the single erroneous infringement contention. Thus, the evidence before the Court at the summary judgment motion indicated that the accused device did infringe. It was the infringement contentions that were given erroneous weight over the evidence before the Court.

Infringement contentions are clearly identified by their label. They are in fact "contentions". In order to establish any claim, pleadings must be drafted to set forth the contentions of the plaintiff to apply the law to the facts of the case. Pleadings frame the allegations of the plaintiff. Those allegations may be further be refined through discovery devices. Modern discovery includes a device known as the "contention interrogatory". Although, contention interrogatories involve attorney work product, they are nonetheless a commonly used and accepted discovery device [FRCP 33(b); *McCarthy v. Paine Webber Group* 168 F.R.D. 448, 450 (N.D. Conn. 1996)]. The fact that contentions are set forth, however, does not mean that the evidence produced

at trial or in response to summary judgment may not reveal variations between that originally contended in the pleadings or in discovery responses. In fact, discovery responses may be freely amended, and parties are obligated to do so (FRCP 26 [e]). Even after a trial the contentions of plaintiff may be modified according to the evidence that is produced (FRCP 15[b]; *First National Bank v. Continental Ill. Nat'l Bank* 933 F.2d 466, 468 [7th Cir. 1991])

Rule 56 motions are similar to a trial. Evidence is taken in summary form, but there is still an evidentiary evaluation of the case and the case is to be determined in a summary judgment upon its merits.

> Evidence presented to defeat a summary judgment motion need not be in admissible form, but it must be admissible in content [*Payne v. Pauley* (Seventh Cir. 2003) 337 Fed. 3rd 767 citing *Stinnett v. Iron Work Gym* (Seventh Cir. 2002) 301 Fed. 3rd 610, 613].

> The evidence of the nonmovant is to be believed and all justifiable inferences are to be drawn in his favor [*Anderson v. Liberty Lobby Inc.*, (1986) 477 U.S. 242, 255; *Adickes v. S.H. Kress & Co.* (1970) 398 U.S. 144, 158-159].

Considering the mandate for ruling on Rule 56 motions in favor of the non-moving party, the Court is not in a position to weigh conflicting evidence, but must accept all competent evidence offered in opposition, irrespective of its form. The Court in this case refused to consider the evidence set forth in the inventor's declaration that clearly established an infringement claim by his comparison of the patent claims themselves to the accused device. Instead, the Court rigidly seized upon the form of the preliminary infringement

contentions insisting upon using it as an exclusive guide in determining infringement.[1]

As described in the "Petition for a Writ of Certiorari" (Petition pages 4 and 5), infringement contentions are merely a characterization or correlation of the claims to be applied to the accused device. They are not the substance of either the claims, nor the device itself. The fact that counsel in a written form misstated the application of the claims to the device, does not belie the plain evidence of the claims themselves, nor their application to the device. In this case, however, the Court's have followed a dangerous trend to exalt the form of the local rules providing a format for correlation and characterization of the claims through the preliminary infringement contentions over the merits of evaluating the evidence itself.[2] The task specifically charged to the Court by the cases is that the "claims must be compared to the accused device." The preliminary infringement contentions are merely a form to assist in that comparison.

---

1. Before the trial Court Mr. Slobodin argued that under the proper application of the local rules that plaintiffs would be entitled to amend as a matter of right. The Court refused this argument contending that in the absence of a claims construction hearing the right to amend did not apply (Appendix C; page 13a). The Court erroneously disregarded that a motion for summary judgment may be a substitute for a claims construction hearing (*Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 981 [Fed. Cir. 1995]), but does not absolve the Court from the task of claims construction. In so far as the term "lower attachment" was to be construed the Court should have considered plaintiffs argument and evidence as to what is actually to be construed as a "lower attachment" to be distinguished from a "coupler" instead of adhering to a draconian application of an erroneous infringement contention.

2. *O2 Micro International Limited v. Monolithic Power Systems, Inc.*, (Fed. Cir. 2006) 467 F.3d 1355; *Massachusetts Institute of Technology v. Abacus Software* (2004) U.S. District Court Lexis 30045.

DEFENDANTS WERE NOT PREJUDICED BY PLAINTIFFS' MISTAKE

Plaintiffs Richard Berger and his son Brant Berger invented the rotatable step-in binding in response to a long felt need in 1996 and applied for provisional patents (A824-825). In January 1997, Rossignol photographed the product at a trade show and began producing an infringing product a year later (A825). Rossignol thereupon began to create favorable pricing arrangements with rental shops, the primary market for the binding, and put the Bergers out of business (A825-826). Thus, Rossignol began manufacturing their infringing product a year before correspondence from Berger's counsel raising issues of infringement and before the final patent had even issued. Thus, Rossignol could not have relied letters sent a year after they had already manufactured the binding and competed heavily in the market to put the Bergers out of business [see: *Gasser Chairco Inc., v. Infanti Chair Mgf.* (Fed. Cir. 1995) 60 Fed. 3rd 770; *Hall v. Aqua Queen Manufacturing Inc.*, (Fed. Cir. 1996) 93 Fed 3rd 1548, and discussion at A791 through A795]. Having been put our of business, it is foreseeable that an inventor/plaintiff may suffer delays in obtaining counsel and funding the prosecution of a patent claim against his competitor who has usurped his invention and stolen his niche in the market place. What prejudice did Rossignol suffer by Bergers' delay in bringing their action–that they were allowed to make money off their ill gotten gains? Both respondent and the trial Court made reference to the delay in bringing the action, however this reference is not only irrelevant to the delay in correcting the infringement contentions, but is unjustified as well.

The trial court analyzed the prejudice that defendants relied on the preliminary infringement contentions for three months and based on such contentions incurred costs creating their own invalidity contentions and preparing their motion for summary judgment. In no respect, however, were

defendants prejudice to the detriment of a claimed defense upon the merits. Only one element of an independent claim was affected by the preliminary infringement contention actually in question. The actual cost to defendants arising from that single element would have been minimal and should have been addressed by way of appropriate monetary sanction, not the complete deprivation of a meritorious patent claim.

PETITIONERS RAISED THEIR ARGUMENTS BEFORE ALL OF THE LOWER COURTS

Contrary to the assertion in the opposition by Rossignol, petitioners did repeatedly raise their contention that their case should be adjudicated upon the merits in the courts below. To the trial court, the plaintiffs wrote,

> according to the Ninth Circuit, "district courts have inherent power to control their dockets, but not when its exercise would nullify the procedural choices reserved to parties under the federal rules." [*Atchison, T. & S. F. Ry. v. Hercules Inc.*, (Ninth Cir. 1998) 146 Fed. 3rd 1071, 174; (reversing dismissal sanction). According to Rule 1, the Federal Rules of Civil Procedure "govern the procedure in the United States district court in all suits of civil nature ... They shall be construed and administered to secure the **just**, speedy, and inexpensive determination of every action (FRCP Section 1; *Atchison* 146 Fed. 3rd at 1074 ("district courts may not follow local rules which are inconsistent with the federal rules.") (A1190)]

This excerpt taken from plaintiffs' motion under Rule 60(b) to vacate the judgment of the trial court precisely raises the inconsistency of the application of the local rules of the

Northern District in contradiction to the FRCP and the unfair adjudication of plaintiffs' claim based upon the form of the local rules and not upon the substance of the evidence before the Court. The arguments were reiterated to the Federal Circuit Court of Appeals in plaintiffs/appellants' opening brief at page 26.

THIS CASE PRESENTS AN IMPORTANT FEDERAL QUESTION ADDRESSING AN ALARMING TREND TOWARD THE DEPRIVATION OF VALID CLAIMS

The strict application of local rules in degradation of trial upon the merits of patent claims is represented by this case, and is a developing trend, not only in the Northern District of California, but throughout the country. The case is not an aberration, but the result of a deliberate policy of the District Courts. The Federal Circuit's decision in *O2 Micro International Limited v. Monolithic Power Systems, Inc.*, (*Supra*), reveals that the standard applied in patent cases is becoming materially different from other federal actions. Specifically, the diligence in adhering to the local rules will be the only material analysis applied to plaintiffs. Once that is found there is no need to consider prejudice to the defense. The decision in *O2 Micro International Limited v. Monolithic Power Systems, Inc.*, and the minimal prejudice considered by the trial court in this case reveal a policy that patent courts will adjudicate cases on the basis of the form of allegations required by the local rules as opposed to the evidence before it. Such an exalting of the local rules is contrary to the Federal Rules of Civil Procedure and to the great weight of authority in American common law that would hold that, absent the most egregious of circumstances which include material prejudice to the defendants, plaintiffs should not be deprived a meritorious claim [*Oliva v. Sullivan* (Ninth Cir. 1992) 958 Fed. 2nd 272, 274; *Atchison, T. & S. F. Ry. v. Hercules Inc.*, (Ninth Cir. 1998) 146 Fed. 3rd 1071, 1074].

The erroneous policy in the Northern District of California represented by this case specifically works an injustice against inventors of modest means who struggle economically to put together the details of their case against an economically superior infringer who abuses its economic superiority to prevent the assertion of valid claims. The United States District Courts should not be an obstacle to the assertion of meritorious claims, but rather should fairly adjudicate all meritorious claims giving deference to calendar control, but as in the case at bar where little prejudice is worked upon the defendant, a minor amendment to the form of infringement contentions required by the local rule presented prior to the ruling on a motion for summary judgment, and as demonstrated by evidence before the Court, should require the Court to rule upon the evidence before it, not upon the defect in form of presentation.

CONCLUSION

For the foregoing reasons and for the reasons set forth in the Petition, this Court should grant the Petition for writ of certiorari.

Respectfully submitted,

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